

REMARKS

Claims 1-5 and 7-18 are pending in this application. Claims 1-5 and 7-18 are rejected. No claims have been added. Claim 18 has been amended. No new subject matter has been added. Claims 1-5 and 7-18 remain pending. Reconsideration of the claims is requested in light of the following remarks.

Claim Rejections – 35 USC § 103**Lin in view of Bloomfield and further in view of Crager: Claims 1-18**

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (U.S. Pat. No. 5,881,064) (“Lin”) in view of Bloomfield (U.S. Pat. No. 6,693,729) (“Bloomfield”) and further in view of Crager et al. (U.S. Pat. No. 4,058,838) (“Crager”).

Claim 1 recites in part:

A fax communication system ... comprising:

A network device coupled to receive fax information from the first fax machine, said network device including an accumulation block for accumulating a portion of the fax information in the form of at least one frame for stalling the second fax machine while accumulating said portion until said portion is determined to be free of errors using cyclic redundancy code (CRC) error checking and correction, said portion being sent to the second fax machine free of errors across the packet switching network to the second fax machine.

Lin involves a node system for use in a data communication network including a plurality of source and destination data communication devices. The node system receives data packets from another node system, and forms image data from the received data packets. The node system selectively inserts fill codes into the image data so that such selective insertion of the fill codes prevents service interruption between the plurality of source data communication devices and the plurality of destination data communication devices by correcting a temporary inability to receive additional data, and by maintaining real time communication between the plurality of source data communication devices and destination data communication devices. The node system is capable of sending the image data and the fill codes to the plurality of destination data communication devices.

Bloomfield involves a fax to E-mail system and related methods whereby a hardcopy document is sent via a fax device to its recipient via electronic mail through a data network, and is delivered in such a manner that it can be retrieved by the recipient at an E-mail device, in the ordinary course of retrieving the E-mail, and displayed on the screen of the E-mail device. The system and method also provides for an interface device which connects to a

conventional fax device for communicating E-mail address and routing hardcopy documents to the E-mail network.

Crager involves a packet-switched facsimile communication system operable in a store-and-forward mode that enables substantially simultaneous full-duplex communication between a plurality of telecommunications terminals, such as facsimile transceivers, over a communications network with a plurality of other facsimile transceivers having access to the communications network.

Applicants submit that a *prima facie* case of obviousness has not been established in the action dated October 7, 2004. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure, M.P.E.P. 2143.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The only evidence offered by Examiner for suggestion or motivation to combine was that "Lin and Bloomfield and Crager are combinable because they are from the same field of endeavor that is facsimile communication in a network environment. The motivation for doing would have been to ensure data transmitted from the fax machine reaches the destination error free." While applicants disagree with this assertion, this statement, even if true, is nonetheless insufficient to conclude it would have been obvious to a person skilled in the art at the time of the invention to combine these references.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of one of ordinary skill in the art, M.P.E.P. 2143.01. Respectfully, none of these are satisfied. The motivation given by the examiner is for an entirely different problem than the claimed invention. The claimed invention has error correction between a fax machine and network device prior to the packet switched network so that additional sending of packet information is not needed to correct for errors between the fax machine endpoints.

Applicants respectfully submit that claim 1 is therefore patentably distinguishable over the prior art. Claims 2-18 deal substantially with the same subject matter and were rejected under the same art. It is submitted that a prima facie case of obviousness has not been met for any claim for the same reasons as expressed above in relation to claim 1. Therefore claims 1-18 are patentably distinguishable over the prior art.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-18 is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Julie L. Reed

Julie L. Reed
Reg. No. 35,349

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613

I hereby certify that this correspondence
is being transmitted to the U.S. Patent and
Trademark Office via facsimile number
(703) 872-9306, on March 7, 2005.

Submitted:

Judy Wigmore
Judy Wigmore